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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/678,668

10/03/2003

Ulf G. Ederer

EDERER ETAL-3

9744

7590

06/19/2006

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EXAMINER

COMPTON, ERIC B

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary**Application No.**

10/678,668

Applicant(s)

EDERER ET AL.

Examiner

Eric B. Compton

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "... the bearing eye surface is processed for a precise fit after assembly of the parts obtained through the fracture separation of the workpiece, before the anti-friction coating is applied to the processed bearing eye surface ..." (emphasis added). This claim language is ambiguous, since it is confusion as to whether the coating is applied before of after the fracture separation. Perhaps, --but— should be inserted in front of "before," to make this clear.

Claim 1 recites the limitation "the parts" in line 4. See *a/so* Claim 3, line 3. There is insufficient antecedent basis for this limitation in the claims. Perhaps, --of the workpieces obtained through the fracture separation-- should be inserted after "the parts" in claim 1, line 4 to provide proper antecedent basis.

Claim 3 recites the limitation "the galvanic bath" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. Perhaps, --in a galvanic bath—should be inserted after "galvanically deposited" in claim 2, line 1 to provide proper antecedent basis.

Claims 2 and 4-8 depend from claims 1 and 3 and thus are also indefinite.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 2002/0104506 to Ederer.

Ederer discloses a method of forming a bearing eye for a connecting rod. The reference notes:

The bearing box 2 is partitioned to accommodate the crankshaft journal, forming a bearing cover 5 which has to be screwed to the other part of the bearing box 2.

It is not only essential for the invention that the bearing bore 3 in the bearing box 2 bears the bearing layer 4, but also that the bearing bore 3 has a contour in the form of grooved recesses 8 distributed over the axial length and running in a peripheral direction, as evident from FIGS. 4 and 5. The bearing layer 4 deposited for example galvanically on the bearing bore follows the contouring of the bearing bore 3, such that the running surface 9 forms a matching contour with respect to spacing likewise in the form of grooved recesses 10. The depth t of these grooved recesses 10 should not be any greater than half the thickness d of the bearing layer 4 and no smaller than a fifth of this thickness d. Depending on the type of bearing layer 4 it can be necessary to provide an intermediate layer 11 between the bearing layer 4 and the bearing box 2 as bonding agent or diffusion barrier, as per FIG. 4. Direct application of the bearing layer 4 without intermediate layer to the bearing box 2 is illustrated in FIG. 5.

[0016 & 0018] (emphasis added). The reference notes, "partitioning" the bearing eye. Generally in the art for manufacturing connecting rods manufacturing this in

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known as a fracture separation. See e.g., Specification, page 1 (disclosing fracture separation for connecting rods). If Ederer does not explicitly anticipate claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to partition the bearing eye by a fracture separation, in order to form a connecting rod.

Allowable Subject Matter


5. Claims 3-8 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 3-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach a method of manufacturing a bearing eye, as claimed in claims 1-2, wherein "before the galvanic deposition of the anti-friction coating, the fracture gap between the parts of the workpieces is sealed in relation to the galvanic bath," in combination with other claimed subject matter.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Eric B. Compton
Primary Examiner
Art Unit 3726

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